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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	:	
Jan ENDRIKAT et al.	:	Group Art Unit: 1616
Serial No.: 09/091,665	:	Examiner: Qazi, S.
Filed: September 2, 1998	:	

For: CONTRACEPTIVE PROCESS AND KIT FOR FEMALE MAMMALS, COMPRISING A COMBINATION OF GESTAGEN AND OESTROGEN

#16

PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicants hereby petition that the Restriction Requirement, initially set forth in the Office Action of March 29, 2000, in the above-referenced application be withdrawn.

The Office Action of March 29, 2000 set forth a restriction requirement in the above-referenced application, which is a national phase application of a PCT. The restriction requirement, citing PCT Rule 13.2, divided the claims into Group I (claims 1-8, later corrected to 1-7, drawn to a contraceptive process) and Group II (claims 9-12, later corrected to 8-12, drawn to kits). Group I was previously elected with traverse.

In the Reply of June 29, 2000, applicants traversed the Restriction, on the grounds that the kit claims of Group II recite the reagents which are used to implement embodiments of the elected method claims of Group I. Thus, no serious burden would be imposed by the further examination of the claims of Group II.

The Office Action of August 15, 2000 maintained the restriction requirement, and alleged that the two Groups lack a "special technical feature" and therefore do not relate to a single inventive concept. However, the Examiner provided no reasons to support this allegation. The Examiner did, however, argue that it would allegedly be a "burden" to

examine all of the claims in the application, a consideration which is not necessarily relevant to restriction in PCT applications.

In the Reply filed January 16, 2001, applicants continued to vigorously traverse the restriction requirement. As was stated in that Reply:

> The two [restriction] groups do, indeed, have unity of invention, because they contain the same special technical feature: the estrogen and gestagen components of the kit are designed to be administered in the same combinations, and under the same schedule of administration, as the estrogen and gestagen components used in the claimed method. Furthermore, there is no serious additional burden imposed on Examiner to search the elements of the kit with the claimed methods. The search for the claimed method necessarily must take into account the materials administered and the manner in which these materials are administered. Thus, the subject matter of the kits will necessarily have already been searched in the search of the method of Group I.
> Absent a serious burden on the Examiner, restriction is not proper. See MPEP §803. Merely, because the two groups are separately classified in the PTO does not mean the searches required for each group are not substantially the same or even identical. It is respectfully requested that the restriction requirement be withdrawn, and that the kit claims be examined with the method claims.

In that Reply, applicants also added new claims 31-35, which are drawn to "contraceptive combinations" which correspond to kit claims 8-12. These combinations are designed to be used in the claimed methods. These combination claims should be examined with the method claims. PCT (371) rules mandate that a combination and method of using it be examined together. See, *e.g.*, 37 CFR §1.475.

In the Final Rejection of April 5, 2001, the Examiner once again maintained the restriction requirement. Furthermore, she withdrew from consideration claims 31-35, on the grounds that

> ...these claims would have been restricted if originally presented. It would require a separate search due to certain limitations which will be an undue burden on the Examiner.

As noted above, PCT rules mandate that combinations and methods of using them must be examined together in a PCT application.

For the reasons set forth above, it is respectfully requested that composition claims 31-35 be considered along with the elected claims of Group I. Furthermore, it is requested

that the non-elected kit claims 8-12 also be examined, because these claims, too, share a common technical feature with the elected method claims.

The Commissioner is hereby authorized to charge any deficiencies in payment of fees associated with this communication or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

Brion P. Heaney (Reg. No. 32,542)
Attorney for Applicants

Nancy J. Axelrod (Reg. No. 44,014)
Patent Agent
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201
Direct Dial: (703) 812-5304
Facsimile No.: (703) 243-6410
Internet Address: axelrod@mwzb.com